

REMARKS/ARGUMENTS

The Applicants hereby thank the Examiner for the observations in the outstanding Office Action, for withdrawing the restriction of January 23, 2006, for withdrawing the rejection of the claims under 35 U.S.C. § 112, second paragraph, and for withdrawing the rejection of the claims on the ground of Higdon (US 5375363) under 35 U.S.C. § 102(b). Claims 4 and 10 are herein amended only for informalities to better encompass the full scope and breadth of the present invention, notwithstanding the Applicants' belief that the claims would have been allowable as originally filed. Accordingly, the Applicants respectfully assert that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2000). Therefore, reconsideration of the present application in light of the foregoing amendments, the premature finality of the rejection, and these remarks is respectfully requested.

I. Objection to Claims 4 and 10 on the Grounds of Informalities

Claims 4 and 10 have been objected on the grounds of informalities. Claims 4 and 10 are herein amended for these informalities, as suggested by the Examiner. Thus, the Applicants believe that herein amended Claims 4 and 10 overcome these grounds for objection on this basis. Therefore, the Applicants respectfully request that these grounds for objection on this basis be withdrawn as to Claims 4 and 10.

II. Rejection of Claims 4 and 9-11 under 35 U.S.C. § 103(a) on the Ground of Higdon (US 5375363), in view of Moore et al. (US 5716161)

Claims 4 and 9-11 have been rejected, under 35 U.S.C. § 103(a), as being anticipated by Higdon (US 5375363), in view of Moore et al. (US 5716161). The Examiner asserts that, with respect to Claim 4, Higdon teaches a body 12, an appendage 16, and a connecting structure 354 and that Moore teaches prongs that extend away from a post 40 and toward a second end of the post 40 to manually install a connecting structure to apertures and quickly

remove the connection structure from the apertures without using tools. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

With respect to Higdon, this reference merely teaches a decoy having a movable neck, the decoy comprising a neck-to-body connector 354 having a pair of flexible ears 364 projecting therefrom and for inserting into a hole 366 of the body 312 (col. 3, l. 67 – col. 4, l. 6). Referring to Figures 3 and 10, Higdon discloses *only two ears* 364 which subtend an *obtuse angle* with the ring structure A2. Further, the term “ears” and the ring structure A2 are low aspect ratio elements by their definition and as shown and described throughout the Specification and drawings of Higdon. The Examiner concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” (Final Office Action, p. 3).

Regarding Moore, this reference merely teaches a retainer clip having a threaded shank with a T-head embedment molded in a hex nut head for rotatably threading the clip into a support. Moore’s retainer clip is a fastener which is **necessarily fixedly disposed** by virtue of “threading the clip into a support” (Abstract). The very purpose of the Moore invention is for retaining a planar sheet material member, such as automotive trim, to an underlying support, such as an automotive body (col. 1, ll. 6-7). As such, Moore even teaches against the present invention claimed features of “a *displaceably suspended* manner” and “the at least one *flexible connecting member comprising a coil spring*” (Claim 4).

Nowhere, in Higdon or Moore, is any express or even implied suggestion to combine the presently claimed elements of independent Claims 4 and 10. Independent Claims 4 and 10, as herein amended only for informalities, as discussed, *supra*, recite the following features believed to be patentably distinct from Higdon, even in view of Moore:

4. A novelty system comprising:
 - a body having a plurality of apertures;
 - one or more appendages corresponding to one or more said plurality of apertures and for securement to project in a *displaceably suspended* manner from said body, each said appendage including at least one flexible connecting member, *the at least one flexible connecting member comprising a coil spring*;
 - and
 - a connecting structure that secures said one or more appendages to said

body, the connecting structure comprising a post with a plurality of prongs flexibly coupled to a first end of said post and adapted to be inserted through said plurality of apertures and retained therein, said prongs extending towards said body to terminate at respective termini for engagement therewith, and the plurality of prongs extending away from said post and toward a second end of said post, one end of said flexible connecting member connected to said connecting structure and another end connected to said appendage.

10. A kit for constructing a novelty comprising:

a plurality of detached novelty portions combinable for shipping said novelty in at least a partially unassembled form, said novelty portions comprising a body with apertures for receiving connecting structures, one or more appendages including *at least one flexible connecting member comprising a coil spring* extending therefrom, and connecting structures for facilitating connection of said appendages to said body by connecting one end of said flexible connecting member to one of said connecting structures and connecting another end to said body,

said one or more appendages being securable upon assembly of said novelty to project in a *displaceably suspended* manner from said body by operatively connecting said connecting structures with said apertures of said body, each said connecting structure comprising a plurality of prongs flexibly coupled to a first end of each said connecting structure to extend towards said body, and said prongs terminating at respective termini for engaging said body.

The Applicants respectfully submit that the “*at least one flexible connecting member comprising a coil spring*” facilitates “one or more *appendages* corresponding to one or more said plurality of apertures and *for securement* to project in a *displaceably suspended* manner from said body[.]” The fastener of Moore is configured in a manner to achieve exactly the opposite structure from that of the present invention, i.e., Moore’s fastener must keep the trim on the car without flopping. The combination of the coil spring, the displaceable suspension, and the remaining features of the present invention are not suggested or motivated by Higdon or Moore, individually or together.

Thus, the Applicants respectfully submit that Higdon, even in view of Moore, does not teach, motivate, or suggest the limitations of herein amended independent Claims 4 and 10 or those of Claims 9 and 11, by dependency. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 4 and 9-11 be passed to allowance.

III. Rejection of Claims 5-7 under 35 U.S.C. § 103(a) on the Ground of Higdon (US 5375363), in view of Moore et al. (US 5716161), as applied to Claims 4 and 9, and in further view of Weiser et al. (US 6599160)

Claims 5-7 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Higdon (US 5375363), in view of Moore et al. (US 5716161), as applied to Claims 4 and 9, and in further view of Weiser et al. (US 6599160). The Examiner concedes that Higdon does not teach that the appendage can be a wing structure, but relies on Weiser for the teaching. The Examiner further concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” as discussed, *supra* (Final Office Action, p. 3), but relies on Moore for teaching a “stiff” fastener. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

Claim 5 is herein amended to recite: “The novelty system of Claim 4, wherein said one or more appendages comprises a wing structure.” Claim 6 is herein amended to recite: “The novelty system of Claim 5, wherein said connecting structure includes a second end for facilitating its connection to said one or more appendages.” Claim 7 is herein amended to recite: “The novelty system of Claim 6, wherein said one or more appendages comprise an enclosure for facilitating its securing to said second end of said connecting structure.” Claims 5-7 subsume the limitations of herein amended Claim 4 by dependency.

Reiterating, Higdon merely teaches a decoy having a movable neck, the decoy comprising a neck-to-body connector 354 having a pair of flexible ears 364 projecting therefrom and for inserting into a hole 366 of the body 312 (col. 3, l. 67 – col. 4, l. 6). Referring to Figures 3 and 10, Higdon discloses *only two ears* 364 which subtend an *obtuse angle* with the ring structure A2. Further, the term “ears” and the ring structure A2 are low aspect ratio elements by their definition and as shown and described throughout the Specification and drawings of Higdon. The Examiner concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” (Final Office Action, p. 3).

As discussed, *supra*, Moore merely teaches a “stiff” retainer clip having a threaded shank with a T-head embedment molded in a hex nut head for rotatably threading the clip into a support. Moore’s retainer clip is a fastener which is **necessarily fixedly disposed** by virtue of “threading the clip into a support” (Abstract). The very purpose of the Moore invention is for retaining a planar sheet material member, such as automotive trim, to an underlying support, such as an automotive body (col. 1, ll. 6-7). As such, Moore even teaches against the present invention claimed features of “a *displaceably suspended* manner” and “the at least one *flexible connecting member comprising a coil spring*” (Claim 4).

In particular, the Applicants respectfully request reconsideration of the propriety of the outstanding final rejection in light of the secondary cited reference, Weiser et al. (US 6599160). The Applicants respectfully resubmit that this reference should be disqualified as prior art under 35 U.S.C. § 103(c)(1) which provides:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time of the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In addition, 35 U.S.C. § 102(e)(2) provides:

a person shall be entitled to a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent,

Applying § 103(c)(1) and 102(e)(2) to the facts of the instant application, the subject matter of the cited reference, Weiser et al. (US 6599160), corresponds to five inventors, Isaac Weiser, Margaret Weiser, Yong-Biao Ye, Xiao-Hong Guo, and Jin-Mao Huang, while the subject matter of the present application corresponds to two inventors, Isaac Weiser and Margaret Weiser. **As such, the subject matter of the present application has been developed by “another person.”**

Further, the cited reference is a patent, i.e., Weiser et al. (US 6599160), granted on an application for patent by another, i.e., the set of five inventors, filed in the United States

before, i.e., the filing date of US 6599160, June 6, 2002, precedes the filing date, July 1, 2003, of the present application by the applicant for patent, i.e., the two inventors. As such, the cited reference would otherwise, and only in the hypothetically, qualify as prior art under subsection (e) of section 102.

Also, the Applicants hereby resubmit the following statement, under MPEP 706.02(l):

The subject matter of the cited reference Weiser et al. (US 6599160) and that of the presently claimed invention were, *at the time of the claimed invention was made*, assigned to and owned by the same person, i.e., the entity Exhart Environmental Systems, Inc., as evident from the face of the patent and from the Notice of Recordation of Assignment Document, Reel/Frame No. 014278/0039.

Consequently, the Applicants respectfully request that Weiser et al. (US 6599160) be disqualified as a § 103(a) reference under 35 U.S.C. § 103(c). In light of Weiser being disqualified as a reference, Higdon, even in view of Moore, does not teach, motivate, or suggest the invention of Claims 5-7.

The Applicants respectfully refer the Examiner to the March 6, 2006, Response (p. 10, ll. 13-16) to the February 2, 2006, Office Action, wherein the Applicants indeed have already made a statement that the common ownership was "*at the time the invention was made.*" In light of this extenuating circumstance, the Applicants respectfully submit that the final rejection is premature and respectfully request that the Examiner withdraw the finality and that the Examiner reopen prosecution.

Thus, the Applicants respectfully submit that Higdon, even in view of Moore, and even in further view of Weiser, does not teach, motivate, nor suggest the limitations of previously presented Claims 5-7. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 5-7 be passed to allowance.

IV. Rejection of Claims 10 and 11 under 35 U.S.C. § 103(a) on the Ground of Weiser et al. (US 6599160), in view of Higdon (US 5375363)

Claims 10 and 11 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Weiser et al. (US 6599160), in view of Higdon (US 5375363). The Examiner concedes that Higdon does not teach that the appendage can be a wing structure, but relies on Weiser for the teaching. The Examiner further concedes that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” as discussed, *supra* (Final Office Action, p. 3). The Applicants hereby respectfully traverse these grounds for rejection on this basis.

Claim 10 is herein amended to recite: “A kit for constructing a novelty comprising: a plurality of detached novelty portions combinable for shipping said novelty in at least a partially unassembled form, said novelty portions comprising a body with apertures for receiving connecting structures, one or more appendages including *at least one flexible connecting member comprising a coil spring* extending therefrom, and connecting structures for facilitating connection of said appendages to said body by connecting one end of said flexible connecting member to said connecting structure and connecting another end to said body, said one or more appendages being securable upon assembly of said novelty to project in a *displaceably suspended* manner from said body by operatively connecting said connecting structures with said apertures of said body, each said connecting structure comprising a plurality of prongs flexibly coupled to a first end of each said connecting structure to extend towards said body, and said prongs terminating at respective termini for engaging said body.” Claim 11 has been previously presented and now recites: “The kit of Claim 10, wherein said connecting structures are insertable into said apertures.”

As discussed, *supra*, the Applicants respectfully request that Weiser et al. (US 6599160) be disqualified as a cited reference for the foregoing reasons. Without Weiser, the Examiner has already conceded that Higdon does not teach that the appendage can be a wing structure and that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” as discussed, *supra* (Final Office Action, p. 3).

Thus, the Applicants respectfully submit that Weiser, even in view of Higdon, does not teach, motivate, nor suggest the limitations of herein amended Claim 10 or those of Claim 11 by dependency. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 10 and 11 be passed to allowance.

V. **Rejection of Claims 10 and 11 under 35 U.S.C. § 103(a) on the Ground of Del Mas (US 2760303), in view of Higdon (US 5375363)**

Claims 10 and 11 have been rejected, under 35 U.S.C. § 103(a), as being unpatentable over Del Mas (US 2760303), in view of Higdon (US 5375363). The Examiner concedes that Higdon does not teach that the appendage can be a wing structure and that, in Higdon, “the prongs 364 do not extend away from the post toward a second end of the post” as discussed, *supra* (Final Office Action, p. 3). The Examiner further concedes that “Del Mas fails to disclose the post comprising prongs flexibly coupled to a first end of the post, and the prongs extending towards the body to terminate at respective termini” (Final Office Action, p. 6), but relies on Higdon. The Applicants hereby respectfully traverse these grounds for rejection on this basis.

Nowhere, in Del Mas or Higdon, can any express or even implied suggestion be found to combine the presently claimed elements of independent Claim 10. Independent Claim 10, as herein amended only for informalities, as discussed, *supra*, recites the following features believed to be patentably distinct from Del Mas, even in view of Higdon. In Del Mas, the reference merely teaches that “**Armholes 15** are adapted to receive ... arm **stumps** comprising plugs 16” (col. 2, ll. 25-28). Further, the term “**stumps**” are **low aspect ratio elements by their definition** and as shown and described throughout the Specification and drawings of Del Mas.

In addition to Del Mas, Higdon merely teaches a decoy having a movable neck, the decoy comprising a **neck-to-body connector 354** having a pair of **flexible ears 364** projecting therefrom and for inserting into a hole 366 of the body 312 (col. 3, l. 67 – col. 4, l. 6). Referring to Figures 3 and 10, Higdon discloses *only two ears 364* which subtend an *obtuse*

angle with the ring structure A2. Likewise, the term “ears” and the ring structure A2 are **low aspect ratio elements by their definition** and as shown and described throughout the Specification and drawings of Higdon.

However, to better encompass the present invention, the following amendments have been made. Claim 10 is herein amended by inserting the language “and the plurality of *prongs extending away from said post and toward said second end*” from withdrawn Claim 1. This being so, the plurality of prongs 27, i.e., *at least two prongs*, subtend an *acute angle* with the post 12. Since the prongs 27 are coupled to the first end of the post 12 and extend away from the post 12 and toward the second end of the post 12, the prongs 27 inherently and necessarily subtend an acute angle with the post 12. In addition, the present invention recites the elements “post” and “prongs,” wherein both terms, by definition, imply an aspect ratio of greater than one, i.e., a higher aspect ratio. As such, the present invention, comprising an acute angular orientation of the high aspect ratio elements, i.e., the prongs 27 in relation to the post 12, is distinct from Higdon, disclosing an obtuse angular orientation of the low aspect ratio elements, i.e., the ears 364 in relation to the ring structure A2.

Reiterating, Claim 10 is herein amended to recite: “A kit for constructing a novelty comprising: a plurality of detached novelty portions combinable for shipping said novelty in at least a partially unassembled form, said novelty portions comprising a body with apertures for receiving connecting structures, **one or more appendages including at least one flexible connecting member comprising a coil spring** extending therefrom, and connecting structures for facilitating connection of said appendages to said body by connecting one end of said flexible connecting member to said connecting structure and connecting another end to said body, said one or more appendages being securable upon assembly of said novelty to project in a *displaceably suspended* manner from said body by operatively connecting said connecting structures with said apertures of said body, each said *connecting structure comprising a plurality of prongs flexibly coupled to a first end of each said connecting structure to extend towards said body, and said prongs terminating at respective termini for engaging said body.*” Claim 11 has been previously presented and now recites: “The kit of Claim 10, wherein said connecting structures are insertable into said apertures.”

PATENT

U.S. Patent Application Serial No. 10/612,094

Response to, Request for Reconsideration of, the Final Office Action dated June 2, 2006

Attorney Docket No. 03-11987

Customer Number

25189

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Thus, the Applicants respectfully submit that Del Mas, even in view of Higdon, does not teach, motivate, nor suggest the limitations of herein amended Claim 10 or those of Claim 11 by dependency. Therefore, the Applicants respectfully request that these grounds for rejection on this basis be withdrawn and that Claims 10 and 11 be passed to allowance.

CONCLUSION

Accordingly, Claims 4 and 10 have been herein amended only for informalities to better encompass the full scope and breadth of the present invention, notwithstanding the Applicants' belief that the claims would have been allowable as originally filed. The Applicants respectfully reassert that no claims have been narrowed within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558, 56 U.S.P.Q.2d (BNA) 1865 (Fed. Cir. 2000). Therefore, reconsideration of the present application in light of the foregoing amendment, the premature finality of the rejection, and these remarks is respectfully requested. The Examiner is further cordially invited to telephone the undersigned for any reason which would advance pending claims to allowance.

Respectfully submitted,

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